LIST G
BARRISTERS

Marcus Fleming



Marcus Fleming has a significant practice in commercial litigation with a particular focus on intellectual property law.

QUALIFICATIONS

Bachelor of Laws (Hons)
Bachelor of Arts

CORRESPONDENCE

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CHAMBERS

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COMMERCIAL LAW

Competition | Consumer Law | Contractual Disputes

INTELLECTUAL PROPERTY

Appellate | Confidential Information | Copyright & Designs | Patents | Privacy & Data Protection | Trade Marks

Marcus has substantial experience in intellectual property litigation, including in relation to patent revocation and infringement proceedings, patent oppositions, copyright infringement proceedings, trade mark infringement proceedings (including related consumer protection law claims and passing off), trade mark non-use applications and oppositions, and proceedings concerning allegations of misuse of confidential information and related breaches of employment duties. Marcus also has extensive experience in proceedings concerning claims for compensation on undertakings as to damages in the Federal Court of Australia in the context of pharmaceutical patent revocation proceedings.

Marcus is regularly listed in Doyle's Guide to Leading Victorian Intellectual Property Barristers (2014-2023) and in Doyle's Guide to Leading Victorian Technology, Media & Telecommunications Barristers (2017-2023).

He is listed in Chambers and Partners for Intellectual Property: The Bar (2021 and 2022). In 2021, he was described as "*very insightful and even-tempered, calm under pressure and a pleasure to deal with - one of a number of rising stars in the IP space at the Victorian Bar*" and "*very clever, particularly knowledgeable about the pharmaceutical industry, and a go-to junior for pharmaceutical patent work*".

He is also listed in The Legal 500. In 2021, he was listed as a 'Rising Star' in the Legal 500 Asia Pacific (2021). In 2022, he was described as "*[s]mart, careful, responsible, knowledgeable, very responsive and efficient. A very safe pair of hands*". In 2023, he was described as "*a measured, targeted and persistent advocate. He is incredibly thorough and his drafting skills are excellent*".

He is also recognised in the 2022, 2023 and 2024 Editions of The Best Lawyers in Australia in the field of Intellectual Property Law, and in the 2023 and 2024 Editions in the field of Life Sciences Practice.

Prior to joining the Bar, Marcus was a Senior Associate at Ashurst Australia where he gained extensive experience in large-scale patent litigation, including acting for Samsung in proceedings against Apple Inc concerning patents for smartphone devices.

Marcus holds a Bachelor of Laws (Hons) and Bachelor of Arts (Chinese language major) from Monash University.

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Recent Cases

PATENTS

Commonwealth Scientific and Industrial Research Organisation v Urrbrae Foods Pty Ltd [2023] FCA 504 – preliminary discovery and request for pre-action production of samples

Ono Pharmaceutical Co, Ltd v Commissioner of Patents [2020] APO 43; [2021] FCA 643 and on appeal in [2022] FCAFC 39 – judicial review of decision in relation to application for extension of term of a standard patent, involving the proper construction of ss 70, 71 and 77 of the Patents Act (led by Bruce Caine KC)

UbiPark Pty Ltd v TMA Capital Australia Pty Ltd [2022] FCA 111 – patent invalidity and infringement in parking system technology (led by Christian Dimitriadis SC)

Sanofi-Aventis Deutschland v Alphapharm Pty Ltd [2018] FCA 2060 and on appeal in [2019] FCAFC 28 – patent invalidity and infringement (led by Tom Cordiner KC and Julian Cooke)

Apotex Pty Ltd v Warner-Lambert Company LLC [2016] FCA 1238, and on appeal in *Warner-Lambert Company LLC v Apotex Pty Ltd* [2018] FCAFC 26 – patent invalidity and infringement (led by David Catterns KC and Neil Murray)

Oakmoore Pty Ltd v ARB Corporation Limited [2019] APO 29 – patent opposition

Claymont Bond Pty Ltd v Sedic [2018] APO 88 – patent opposition, and subsequent appeal to Federal Court of Australia

TRADE MARKS, PASSING OFF AND CONSUMER PROTECTION

Brick Lane Brewing Co Ltd v Torquay Beverage Company Pty Ltd [2023] FCA 66 – alleged contravention of ACL in features of design or "get up" (led by Ed Heerey KC)

State Street Global Advisors Trust Company v Maurice Blackburn Pty Ltd [2021] FCA 137, and on appeal in [2022] FCAFC 57 – contravention of the ACL, trade mark infringement, passing off, copyright infringement and contractual interference (led by David Studdy SC)

Urban Alley Brewery Pty Ltd v La Sirène Pty Ltd [2020] FCA 82, and on appeal in [2020] FCAFC 186 – trade mark infringement, contravention of the ACL and passing off (led by Ed Heerey KC)

Samuel Smith & Son Pty Ltd v Pernod Ricard Winemakers Pty Ltd [2016] FCA 1515 – trade mark infringement (led by Bruce Caine KC)

Khaos Group Pty Ltd v State Street Global Advisors Trust Company [2023] ATMO 68 – trade mark opposition (non-use)

Noshu Foods Pty Ltd v Torquay Beverage Company Pty Ltd [2023] ATMO 29 – trade mark opposition

Noshu Foods Pty Ltd v Torquay Beverage Company Pty Ltd [2022] ATMO 221 – trade mark opposition (non-use)

Choo La La Pty Ltd [2022] ATMO 179 – trade marks – s 38 proceeding

Dale Cleves Music Pty Ltd v Allans Musical Instruments Pty Ltd [2022] ATMO 51 – trade mark opposition

EMI (IP) Limited v Spotlight Pty Ltd [2022] ATMO 40 – trade mark opposition

Richards v Black Star Pastry Pty Ltd [2022] ATMO 1 and [2022] ATMO 2 – trade mark oppositions

Manuka Honey Appellation Society Incorporated v Howes [2021] ATMO 64 – trade mark opposition

Warehousing Equipment Pty Ltd v Troden Equipment Pty Ltd [2021] ATMO 43 – trade mark opposition

Geowan Pty Ltd v Senceive Ltd [2020] ATMO 133 – trade mark opposition

3Floorsup Pty Ltd v Fiix Inc [2019] ATMO 177 – trade mark opposition

COPYRIGHT AND DESIGNS

State of Escape Accessories Pty Ltd v Schwartz [2020] FCA 1606, and on appeal in [2022] FCAFC 63 – copyright infringement (work of artistic craftsmanship) and contravention of the ACL (with Luke Merrick)

Henley Arch Pty Ltd v Del Monaco [2019] FCCA 3848 – copyright infringement in house plans (led by Tom Cordiner KC)

The Pokémon Company International Inc, v Redbubble Ltd [2017] FCA 1541 – copyright infringement and contravention of ACL (led by Richard Cobden SC)

Re Aristocrat Technologies Australia Pty Ltd [2020] ADO 4 – examination of design under s 63 of Designs Act

CONFIDENTIAL INFORMATION AND EMPLOYMENT DUTIES

Directed Electronics OE Pty Ltd v OE Solutions Pty Ltd [2022] FCA 1404 – breach of contract, breach of directors' duties, misuse of confidential information and copyright infringement (led by Adrian Ryan SC and with Ryan Maguire)

Verix Pty Ltd v Williams [2021] FCA 748 – breach of contract, breach of directors' duties, misuse of confidential information and copyright infringement

Bucher Municipal Pty Ltd v Crozier – breach of contract, breach of employee duties, misuse of confidential information, copyright infringement and contravention of the ACL (led by Ed Heerey KC and with Lucy Davis – settled prior to trial)

Lift Shop Pty Ltd v Next Level Elevators Pty Ltd – breach of copyright, misuse of confidential information, contravention of the ACL and breach of employee duties (led by John Hennessy SC)

Memberships

Victorian Bar - Commercial Bar Association